

means, mounted in the housing, for converting the motion video signal into a sequence of digital still images;

a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format;

means for reading at least a portion of the sequence of digital still images to generate a motion video signal therefrom; and

a motion picture editing system within the housing for specifying a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium.

REMARKS

In view of the foregoing amendments and following remarks, reconsideration is requested. Claims 1-2 and 4-44 remain in the application of which claims 1, 9 and 23 are independent. Claim 1 has been amended.

The Information Disclosure Statement provides a Japanese language reference that was cited and applied in a related U.S. Patent Application Serial No. 08/932,993. An English language translation was obtained by the Applicant and also is enclosed.

Claims 1-2 and 4-44 were rejected under 35 U.S.C. 103 in view of U.S. Patent 5,946,445 (Peters), U.S. Patent 5,109,482 (Bohrman) and other information relied upon by the Examiner. The Examiner relies on admitted prior art, facts of which the Examiner has taken Official Notice, other facts which the Examiner has asserted are well-known, and in re Larson, 340 F.2d 965 (CCPA 1971).

The information relied upon by the Examiner can be summarized as follows:

1. Peters teaches a device that receives a video signal and stores video information in data files on a digital random-access computer readable and rewriteable recording medium.
2. The admitted prior art teaches that a camera and a video tape recorder may be in two separable and connectable parts. The admitted prior art relied on by the Examiner is found at page 4, lines 18-20 and 26-28, in the specification, part of which is described in Japanese publications 63-9907, 56-134889 and 61-187165.

3. Bohrman teaches a system that allows editing of stored video information.
4. Facts allegedly supported by Official Notice:
 - a. Facts of which the Examiner has taken Official Notice include:
 1. Using shock absorbing cushions to prevent vibration and firmly hold a part is well-known.
 2. Using means for calibration of color of a picture is well known.
 3. Overlaying date or time code or information on a picture is well known.
 - b. The Examiner has asserted that the following are well-known:
 1. Ruggedizing a device.
 2. Using a display function and input mechanism associated with the display function to enable a user to select an associated function.
 3. Using a data address bus to provide data to a computer network.
 4. Using an encoder for encoding a video signal comprising digital still pictures.
5. Reliance on Legal Precedent. The Examiner has relied on in re Larson for the proposition that combining two separate parts to become an integral part is obvious in view of a practitioner in the art.

The Examiner concluded the Final Office Action with the following summary of the rejection: "Since the claimed video system is merely formed by the well-known parts putting together, the combination of a camera, digital recorder as taught by Peters and the editor as taught by Bohrman would produce the claimed video system." See page 7, last sentence before "Conclusion."

A proper obviousness rejection is a fact-intensive inquiry that requires a determination of whether an invention *would have been* obvious to a hypothetical person of skill in the art *at the time the invention was made*. Several findings of fact must be made, particularly a finding of a reason why one of ordinary skill in the art would have found the invention to be obvious. Such findings of fact must be supported by *substantial evidence*. Given these facts, the legal finding of obviousness or nonobviousness is made by "casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." in re Dembiczak, 175 F.3d 944 (Fed. Cir. 1999).

As noted above, the prior art teaches, 1. a device that receives a video signal and stores video information in data files on a digital random-access computer readable and rewriteable

recording medium, 2. a camera and a video tape recorder that can be in two separable and connectable parts, and 3. a system that allows editing of stored video information.

Regarding the independent claims, the rejection is based on an assertion that the claims are directed to no more than the combination of well-known things, and that one of ordinary skill in the art would have combined the things taught in the prior art "to provide convenience to the user." This is the only reason provided for the Examiner for combining the prior art. There is no evidence, however, in this record to support the Examiner's assertion that, *at the time the invention was made*, one of ordinary skill in the art would have recognized that the proposed combinations (in particular, the combination of a motion video camera and an editing system with a digital random-access computer readable and rewriteable recording medium in the same portable housing) "would provide convenience to the user." This lack of evidence to support the Examiner's allegations of motivations to combine prior art references renders the rejection improper.

The Examiner also relied on In re Larson. Such reliance on In re Larson is misplaced. The Examiner is applying this decision as if it set forth a per se rule of obviousness. The Federal Circuit has made it clear that there are no per se rules of obviousness, and that such "rules" are NOT evidence and cannot be the sole basis for a rejection

"The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention—including all its limitations—with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction."

In re Ochiai, 72 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). Here the Examiner has erred by resting his *prima facie* case of obviousness on the purportedly controlling nature of the decision

in in re Larson rather than on particularized findings, as required by Graham v. John Deere, 383 U.S. at 17. Therefore the rejection must be withdrawn.

Regarding the dependent claims, the Examiner has relied only upon taking Official Notice that certain things are known in the prior art. The facts of which Official Notice has been taken are generalities and are not specific to video processing in a camera. No allegation of any motivation to combine such teachings is provided, other than the assertion that these things are, in general terms, well known. The rejection is therefore improper and must be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this reply, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-0876.

Respectfully submitted,

McKain et al.

By: 

Peter J. Gordon, Reg. No. 35,164
Avid Technology, Inc.
One Park West
Avid Technology Park
Tewksbury, Massachusetts 01876
Tel. No.: 978.640.3011
Attorney for Applicant

Date: April 16, 2001

Docket Number: A95001C2

CLAIMS AS AMENDED

1. A digital motion picture recorder, comprising:
a housing sized to be portable for use by an individual;
a motion picture camera mounted in the housing, and providing a motion video signal as an output;
means, mounted in the housing, for converting the motion video signal into a sequence of digital still images;
a digital, computer-readable and writable random-access medium mounted in the housing and connected to receive and store the sequence of digital still images in a computer-readable file format;
means for reading at least a portion of the sequence of digital still images to generate a motion video signal therefrom; and
a motion picture editing system within the housing for [editing] specifying a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium.